

REMARKS

Applicants respectfully request reconsideration of this Patent Application, particularly in view of the above Amendment and the following remarks. No additional fee is required for this Amendment as the number of independent claims has not changed, and the total number of claims is less than previously filed.

Amendment to the Claims

Claim 1 has been amended to clarify the claimed invention, to include limitations of Claim 20, and to further describe the deformed part (5). Claim 25 has been amended to include limitations of Claims 26, 29, and 30. Dependent claims have been amended or canceled in view of the amended Claims 1 or 25, or in response to the Office Action. No new matter has been added to the claims by this Amendment.

Claim Rejections - 35 U.S.C. §112

The rejections of Claims 1, 31-34, and 39 under 35 U.S.C. §112 are moot in view of the above Amendment. Claim 1 has been amended and Claims 31-34 and 39 have been canceled.

Claim Rejections - 35 U.S.C. §102

The rejection of Claims 1, 20, 21, 25-27, 35, 37, and 39-41 under 35 U.S.C. §102(b) as anticipated by Schut et al., DE 10044771, is respectfully traversed.

Schut et al. discloses narrow incisions 6 formed in the mouthpiece case 1 to create paper strips (which appear to be similar to the grooves/teeth discussed at page 8, second paragraph, of the Substitute Specification). Schut et al. does not disclose or suggest Applicants' deformed part recited in Claim 1 that is disposed at an end of the mouthpiece (1) within the cavity (4) of the envelope (2) and that comprises a portion of the end that extends across the second cavity (3) and contacts the opposing inner side wall of the second cavity (3), and where clearances are formed on sides of the deformed part (5) between the deformed part (5) and the inner side wall of the second cavity (3).

Schut et al. also does not disclose or suggest Applicants' recited separating partition in Claim 25 that is selectively penetrable by smoke and has a form of a perforated diaphragm (8) or a spiral insert (9) installed to overlap at least a partial cross section of a cavity (3) of the mouthpiece (1).

For at least these reasons Schut et al. does not anticipate Applicants' claimed invention.

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Claim Rejections - 35 U.S.C. §103

The rejection of Claims 22, 23, 29-31, 33, and 35 under 35 U.S.C. §103(a) as being unpatentable over Schut et al., DE 10044771, in view of Arneson, U.S. Patent 2,542,612, is respectfully traversed.

Arneson is applied for teaching perforated and spiral filter elements. The Office Action notes that the end filters of Arneson are for keeping tobacco particles from the user. Schut et al. also uses an end filter 4, and from the teachings of Arneson perhaps one would substitute the filter 4 (not the element 6) of Schut et al. with the tip filter attachment of Arneson, however that would not provide Applicants' claimed invention. Applicants' claimed invention requires a perforated or spiral shaped separating partition at a position within each of the mouthpiece (1) and the envelope (2). The prior art combination at best provides similar structures, but no teaching, suggestion, or motivation for combining those structures according to Applicants' claimed invention.

For at least these reasons, Applicants respectfully assert the claimed invention would not have been obvious over the combination of Schut et al. and Arneson. Favorable reconsideration and withdrawal of this rejection are respectfully requested.

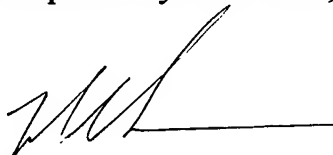
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Conclusion

Applicants intend to be fully responsive to the outstanding Office Action. If the Examiner detects any issue which the Examiner believes Applicants have not addressed or resolved in this response, the undersigned attorney requests a telephone interview with the Examiner.

Applicants sincerely believe that this Patent Application is now in condition for allowance and, thus, respectfully request early allowance.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'MDS', followed by a horizontal line.

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